

REMARKS

By the foregoing amendment, the cross reference occurring on page 2 has been corrected. Claims 1-9 are in the application and at issue.

Addressing the matter of the foreign document cited on page 2 of the application, it is not presently believed to include essential subject matter but is mainly cited as illustrative of the background out of which the present invention arose. A copy of the document (EP 99107601.9) is enclosed as of possible interest to the Examiner.

The request for a translation of DE 197 24 728 is noted with a certain degree of puzzlement, particularly in view of the comments vis-a-vis a lack of financial burden to the assignee of the instant application. As the Examiner knows, translations of foreign documents are available within the PTO to PTO Examiners through the Scientific Library and it is believed that a more meaningful and less speculative first Office Action would have been rendered had the Examiner taken advantage of this service rather than placing the burden on the Applicants after the Office Action was issued. In any event, in the spirit of cooperation and in order to advance the prosecution, a translation obtained by the Applicants is enclosed.

Before addressing the various "requirements" imposed by the Examiner in the paragraph spanning pages 2 and 3 of the Office Action, a

review of the law regarding what is and what is not prior art is believed to be in order.

The CAFC and/or its predecessor court, the CCPA, has universally held that "prior art" under the 1952 Patent Act are those occurrences or things set forth in 35 U.S.C. §102. In the usual case, and this is believed to be a usual case, §§102(a) and 102(b) are the relevant definitions of prior art. §102(a) provides that prior art is that known or used by others in this country or patented or described in a printed publication in this or a foreign country before the invention thereof by the Applicant for patent. (Emphasis supplied) As the Examiner has recognized, Messrs. Ehlers and Zobel were inventors of the '728 invention and are also Applicants for this particular patent. In short, they are not "others" with their own invention as set forth in this particular patent application. Furthermore, the record indicates that they are German citizens and so they are certainly not "others" in this country. Consequently, whatever they know or knew about largeness, length, width and thickness or type of heat exchanger that is shown in the '728 patent but not disclosed there is not knowledge or use by others in this country that can be relied upon as prior art in a rejection under §102(a).

Indeed, even assuming arguendo that the '728 document discloses the invention herein (a proposition that is vigorously disputed by the Applicants), the same is not thought to be a relevant printed publication or a pat-

ented invention in this or a foreign country describing the claimed invention, because were that the case, Messrs. Ehlers and Zobel would have already invented it prior to its patenting or description in a printed publication; and the patenting and/or description in the '728 printed publication could not possibly have occurred before their invention.

In short, §102(a) is clearly inapplicable in this case as far as the '728 document is concerned.

§102(b) specifies that prior art to the claimed subject matter herein must have been patented or described in a printed publication in this or a foreign country more than one year prior to the effective filing date of this case. It appears from the translation that the '728 document was published on February 25, 1999. Applicant has claimed priority of a German application filed on October 21, 1999, less than one year after the apparent publication date of the '728 document. As a consequence, the '728 document would not qualify as a patenting or a description in a printed publication of the type envisioned by §102(b) and this part of §102(b) would appear to be inapplicable.

§102(b) also specifies that prior art is that the claimed subject matter was in public use or on sale in this country for more than a year prior to the application in the United States and since 35 U.S.C. §119 makes the effective filing date October 21, 1999 by virtue of the claim of priority herein, for the public use or on sale provisions of §102(b) to be applicable, they would have

had to occur earlier than October 21, 1998. There is no evidence of record, and the Applicant knows of no evidence not yet of record, amounting to a public or an offer for sale in this country prior to October 21, 1998. Accordingly, §102(b) in its entirety would appear to inapplicable in the present case.

In order to avoid a prolongation of the Examiner's inquiry regarding the subject matter of the '728 document, undersigned counsel states that he has been advised by a representative of the inventors that the structure illustrated in the '728 document was (a) never built, (b) never publicly disclosed or offered for sale in the USA, or (c) never shown in a printed publication such as an advertisement, a magazine, or a published patent application prior to October 21, 1999 except for the publication of the '728 document itself.

In short then, it would appear that the '728 patent document is not prior art in this case and that all rejections based thereon should fail.

Nonetheless, because Applicants believe that the '728 patent is not "highly relevant" as the Examiner has suggested because, indeed, as the Examiner himself has admitted, the drawings are "extremely ambiguous", for the purposes of the next Office Action only, Applicant will permit the Examiner to treat the '728 document as though it were prior art, while reserving the right to proceed thereafter, either before the Examiner, the Board of Appeals or its reviewing courts with its belief that it is not, in fact, prior art cognizable under the statute.

To the extent the Examiner determines to proceed as though the '728 document is prior art, it is axiomatic that it is good for only what it shows, what is clearly inherent in it or what it suggests. Here, the alleged prior art '728 document is the one of concern and can be utilized only for the purposes of what is disclosed therein or inherent in it or which might be suggested to one with ordinary skill in the art upon reviewing the '728 document. The law does not permit thoughts of the inventors of the '728 disclosure that are not in fact incorporated in the '728 disclosure to be used as prior art. Consequently, to the extent that some feature not disclosed, inherent, or obvious in view of the '728 disclosure was known to the inventors, that knowledge is totally irrelevant to any rejection based on the '728 disclosure.

It matters not whether the inventors contemplated that one heat exchanger be smaller in depth than other heat exchangers or that one is thicker than the other or envisioned an exact shape for the front and rear panels for the heat exchange system of the '728 patent if those details are not described in it or suggested by it. It is solely what is disclosed in the '728 patent and what can be derived by one with ordinary skill from that document. Similarly, what Messrs. Ehlers and Zobel might come up with in terms of a cross-sectional shape at this point in time of the '728 device is likewise irrelevant. What is relevant is what one with ordinary skill in the art, after reviewing the '728 patent, might consider to be a cross-sectional sketch, not what the inventors

envisioned at the time of the original filing of the application resulting in the '728 document or what they think it looks like now. Consequently, the information asked for by the Examiner is irrelevant and any attempt to provide Messrs. Ehlers and Zobel's thoughts in the fall of 2002 simply invites shear and legally noncognizable speculation. It would offer the potential for myriad additional irrelevant inquiry and thereby introduce considerable mischief into the examination proceedings herein. Consequently, counsel respectfully declines to produce this information, stating that the Examiner must content himself with only that information which is disclosed in the '728 document, features that are clearly inherent in it or features that might be suggested to one with ordinary skill in the art upon viewing the '728 document itself.

Turning now to the specific rejections, the rejection of claims 1-9 under §102(b) or in the alternative, as obvious over the '728 disclosure is traversed. On its face, the rejection is defective since the Examiner concedes that he is unsure what differences are there between the '728 document and the claimed invention. Consequently, the Examiner is unable to point out where each and every element in these claims finds response in the '728 document. As it is axiomatic that each and every feature of a claimed invention must be found in a single document for a §102 rejection to be proper, and the Examiner is admittedly unable to do this, a §102 rejection is improper. And to the extent that *Graham v. John Deere* requires that the differences between the prior art

and the claimed invention be ascertained in assessing the propriety of a §103 rejection, and the Examiner has been unable to determine what differences there are, it follows that a §103 rejection is similarly improper.

Returning to Office Action comments appearing near the bottom of page 2, Applicants note that the translation of the '728 document indicates that the top heat exchanger 3 is a charge air cooler. However, Applicant does not agree that the depiction of the three heat exchangers illustrated in Fig. 1 of the '728 document show a difference in depth or that the thickness of the top heat exchanger 3 appears to greater than that of the side heat exchangers 2 and 4.

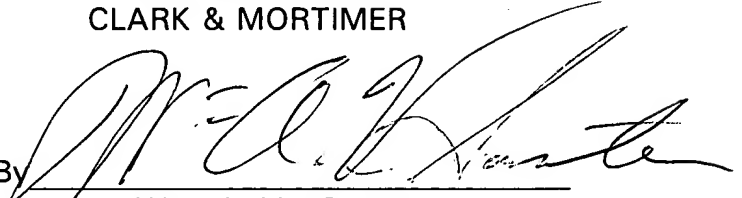
The further rejection of claims 1-9 under 35 U.S.C. §103(a) are traversed for the same reasons set forth above. While Ireland, Bentz or Hauser teach a "centrifugal" fan [sic, a radial fan?], it does not buttress the rejection because of the deficiencies in the '728 disclosure. Consequently, the addition of these references neither strengthen nor otherwise validate the basic ground of rejection and the rejection cannot be supported.

In summary then, it is submitted that the '728 publication is not prior art and that even if considered as prior art, it is deficient in failing to disclose the claimed relationship of core width of one heat exchanger to another. Lacking any suggestion for this claim requirement, the claimed subject matter clearly patentably delineates over the '728 patent, whether or not con-

sidered with the secondary references. Withdrawal of the rejection and the passing of the case to issue are accordingly solicited.

Respectfully submitted,

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